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EXAMINER

ENG, DAVID Y

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/811,677
Filing Date: March 29, 2004
Appellant(s): PARSONS ET AL.

Stewart J. Womack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 22, 2008 appealing from the Office action mailed April 22, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments after Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The Examiner would like to further summarize the claimed invention as follow.

Appellants' invention is a method of doing business. The steps as claimed are not machine implemented steps. The steps are outlines or a business plan for assisting an entrepreneur to establish an Internet business. Steps B to D are services which are inherently needed (essential) for an entrepreneur to establish an Internet business. Step

Art Unit: 2455

A suggests creating a web site (a Facilitator's web site) for providing the services for an entrepreneur to establish an Internet business. An entrepreneur is able to obtain services recited in steps B to D from the facilitator's web site created in step A so as to establish his own Internet business.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,219,327

Jacobs et al

5-2007

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

Claims 1-21 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Art Unit: 2455

Step A suggests creating a facilitator's web site for use by an entrepreneur to establish an Internet business (Internet business like Dell or Amazon selling merchandise over the Internet through their web sites).

Step B suggests that in order to establish an Internet business, the entrepreneur is required to register the domain name (like "dell" in www.dell.com) of his business web site (like www.dell.com) first so that no one can use that domain name.

Step C suggests that in order to establish an Internet business the entrepreneur is required to design and create a business web site for his Internet business.

Step D suggests to the entrepreneur that he needs host service for hosting his business web site such that his customers are able to access the business web site through the Internet.

It can be seen that the steps as recited in the claims are not machine implemented steps. Appellants' invention is a method of doing business. The steps as recited are outlines, thoughts or business plan for an entrepreneur in establishing an Internet business. An entrepreneur is able to obtain services recited in steps B to D from the entrepreneur's web site created in step A so as to establish his own Internet business. The steps are **not for creating a web site by a computer**. Following the steps does not result in creating a web site. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process (page 10 of In Re Bilski 88 USPQ2d 1385).

Claim Rejections - 35 USC § 103

Claims 1-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobs (USP 7,219,327).

Claims 1, 6, 13, 20, 21

Attention of the Board is respectfully directed to claim 1 in Jacobs. Jacobs teaches a method for creating a web site. In Jacobs, the created web site is not for assisting an entrepreneur in creating an Internet business and therefore the created web site does not provide services recited in step B to D. Steps B, C and D are essential steps for a business conducted via a web site (Internet business). If the intended use of the created web site is for assisting an Entrepreneur in creating an Internet business, it would have been obvious to include steps B-D in the created web site because they are inherent steps (essential steps, without them Internet business is impossible). The combination would have been an obvious combination.

Claims 2-5, 7-12, 14-19

The steps of assisting an entrepreneur in copyrighting, trade-marking, selecting options and search engines are not essential steps of creating an Internet business. Rather, they are directed to a specific type of business which an entrepreneur may select to establish. It would have been obvious to a person of ordinary skill in the art to incorporate the services in the created web site which are needed to establish the specific type of Internet business the entrepreneur selected to establish so that he is able to start his Internet business.

Art Unit: 2455

Appellants did not provide any arguments as to why the dependent claims are patentable or why the rejection is in error. Appellants rely on the limitations of their parent independent claims for patentability. All dependent claims are therefore stand or fall with their parent claims.

(10) Response to Argument

A. 35 USC 101 Rejection

Appellants contended that the processes are described in the specification as being performed by and on real world instrumentalities such as computers and Internet. It is true that a computer is needed to create a web site. However, the claims are not directed to a process implemented by a computer for creating a web site. Following the claimed steps does not result in creating a web site. Appellants disclosed invention is not a process for creating a web site using a computer. This is evidenced by Appellants' specification which **did not disclose** computer implemented steps for creating a Facilitator's web site. The step of **using a computer** to create a Facilitator web site (step A) is not a computer implemented step. It is a thought or a method of doing business. It is like using a computer to assist a cashier in a department store. The act of using a computer to create a web site or the act of using a computer to assist a cashier is not a computer implemented step. The steps performed by a computer for arithmetic operations such as addition or subtraction having an arithmetic end result are statutory but not the act of using a computer to perform arithmetic operations.

Art Unit: 2455

Appellants fail to provide any arguments or evidences showing that the steps claimed are implemented by a computer and the end result of the method steps is generated by a computer.

B. 35 USC 103 Rejection

Appellants contended that the Jacobs reference does not teach steps B to C and that the Examiner is relying on Appellants' specification in determining that claimed steps B to D are essential or inherent. The Examiner disagrees. The Examiner did not rely on Appellants' specification for the teaching of steps B to D. The Examiner relies on **the fact** that those steps are essential in establishing an Internet business.

Step B suggests that in order to establish an Internet business, the entrepreneur is required to register the domain name (like "dell" in www.dell.com) of his business web site (like www.dell.com) first so that no one can use that domain name. Registering a domain name is an essential step because Internet communication system does not work if there are two identical domain names. It is like having two identical addresses in US Postal Service. Domain name therefore is required to be registered to exclude others from using it.

Step C suggests that in order to establish an Internet business the entrepreneur is required to design and create a business web site for his Internet business. A web site is essential in establishing an Internet business. A web site to an Internet business is like a physical store to a department store. Without a web site, there is no Internet business. A web site therefore is essential.

Art Unit: 2455

Step D suggests to the entrepreneur that he needs host service for hosting his business web site on the Internet such that his customers are able to access the business web site through the Internet. Host service is for hosting an Internet business's web site on the Internet. Without hosting service, the Internet business's web site would not be posted on the Internet, the customers can not access the web site through the Internet and there would not be any e-commerce. Step D therefore is essential.

Giving the fact that steps B to D are essential, it would have been obvious to a person of ordinary skill in the art to incorporate the services set forth in steps B to D in the Facilitator's web site such that the entrepreneur's web site created using the Facilitator's web site is ready for e-commerce business. It is an obvious combination.

Appellants fail to provide any arguments as to why steps B to D are not essential.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/DAVID Y. ENG/

Primary Examiner, Art Unit 2455

Conferees:

/Zarni Maung/

Primary Examiner, Art Unit 2451

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